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09/909,300	07/19/2001	Jiro Onishi	CU-2599 WDD	1834

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 3/5/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 6-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 6-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 6-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, despite the recent extensive claim amendments, quite a few problems still remain. The Examiner in the following rejections refers to the page and line number taken from the marked up version of the amended claims. In claim 6, line 2, and also in claims 15, 16 and 18 the language "comprising (or comprises) at least" is clearly informal and it is suggested to delete "at least" wherever it exists. In claim 6 line 2, before "substrate" add --separable-- so as to give antecedent basis to the same amendment made in the next line. In claims 6 and 18 the characterization of certain adhesive layers as being a "different material" from another layered element is clearly vague and indefinite, i.e. particularly at the microscopic or molecular level, virtually everything is "different" from another embodiment. Additionally, although perhaps a 112 first paragraph rejection, the phrase "intermediate layer" in the next to last line of claim 6 is clearly vague and indefinite since it is believed to read upon just about anything. In claim 8 the phrase "is contained" is clearly improper and also claims 10 and 11 appear to be

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duplicates of claims 8 and 9, respectively; also note that claims 10 and 11 contain the aforementioned phrase "intermediate layer" and furthermore the use of "connected" as describing some sort of layered relationship is seen as vague and indefinite. In claim 7, line 2 change "the" to --a--, and "excellent" to describe an adhesive characteristic, and also "nature" to describe paper are each seen as clearly informal. In claims 15 and 16 the phrase "having various colors" is vague, indefinite and confusing, as is the phrase "as the plane, shape and size" (each of the last two objected to phrases being found in more than one location) in claims 15 and 16. Additionally, the phrases in claims 15 and 16 "without wasting" either the coloring material or the transfer-receiving material (the latter phrase being misspelled in the last line of claim 15) is also seen as clearly improper.

Finally, the Examiner makes the observation that other such informalities may have not been noticed and should be corrected.

3. Claims 6-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -077, substantially for the reasons set forth in paragraph No. 4 of Paper No. 4, together with the following additional observations. Applicants argue that their amended claims now feature (Response, page 37) a transferring adhesive layer which comprises at least three layers, namely an uppermost layer, an intermediate layer, and a basement layer arranged in this particular order, whereas the relied upon prior

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art (e.g. Figure 1 in the corresponding disclosure) discloses only a single unitary adhesive layer 3. Additionally, it is further noted that the uppermost layer has a glass transition temperature of not less than 60°C. However, the Examiner believes that since the transferring adhesive layer's uppermost layer and basement layer are defined as only being "different" which the Examiner believes can be met by a great number of the adhesive layers disclosed by the European reference, since "different material" or "different adhesive" is believed met, particularly at the molecular or microscopic level. Additionally, the third layer of applicants' claimed "transferring adhesive layer" is defined only as an "intermediate layer" but given no other properties whatsoever except for those set forth in the specification. Note also in the specification at page 38, top paragraph, applicants teach "it is preferable that the intermediate layer 25 is formed of the material which have the adhesive property to adhere firmly to both a basement layer 24 and the uppermost layer 26," which the Examiner respectfully submits is met by either one of the compositions of the uppermost layer or the basement layer. In summary then, the Examiner's position is that it is, if not inherent, at least believed to be obvious that the adhesive layer 3 of EP -077 could be split into three such layers, particularly after processing is finished, which three layered elements would read upon ~~each of~~

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the three claimed adhesive layers<sup>sandwich</sup> set forth by applicants as making up their transferring adhesive layer.

Applicants also argue (Response, page 37, next to last paragraph) that materials suitable for use in the basement layer should not be used for the uppermost layer because of the danger of having blurring occur in the transferred image. However, nowhere is any support for this particular proposition seen or pointed out, and it is also noted that this particular limitation is not found in applicants' claims. Finally, the Examiner further notes that applicants' claimed layer 18 does not contain the presence of an "intermediate layer" so the above set forth analysis regarding the presence of the intermediate layer is not required. Other parameters, such as the presence of an ionomer as one of the ingredients of the adhesive layer and a Bec's Smoothness parameter are each believed to be, if not expressly or inherently disclosed, obvious optimization parameters to one of ordinary skill, in the absence of unexpected results.

4. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

August 28, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*